

EXHIBIT D

EXHIBIT D

PENDING AMENDED INDEPENDENT CLAIM 1
UNITED STATES PATENT APPLICATION SERIAL NO. 09/168,664

Twice Amended Text	Gormish, et al. patent	Bowater et al. patent Davis et al. patent
<p>A method for producing a compressed video bitstream that includes</p> <p>compressed video data for a plurality of frames</p> <p>from data that specifies a single still image,</p> <p>the method comprising the steps of:</p> <p>fetching the data for the single still image;</p>	<p>Disclosed in the Gormish, et al. patent.</p> <p>Not disclosed in the Gormish, et al. patent.</p> <p>Not disclosed in the Gormish, et al. patent.</p> <p>The Gormish, et al. patent discloses a method for processing:</p> <ol style="list-style-type: none"> 1. sequences of image frames; or 2. other types of data sharing similar characteristics of frame sequence data. <p>(Col. 4, lines 55-58)</p>	<p>Disclosed in the Davis, et al. patent.</p> <p>Not disclosed in either the Bowater, et al. or Davis, et al. patents.</p> <p>Not disclosed in either the Bowater, et al. or Davis, et al. patents.</p>

Applicant : Mark D. Conover
 Serial no : 09/168,644
 For : ENCODING A STILL IMAGE
 INTO COMPRESSED VIDEO
 Art Unit : 2613

Docket no. 2134
 Filed: October 8, 1998

Examiner: Richard Lee

encoding the data for the still image into data for an intra ("I") frame;	<p>The Gormish, et al. patent does not disclose:</p> <ol style="list-style-type: none"> 1. encoding compressed video data; 2. <u>from data that specifies a single still image.</u> <p>The Gormish, et al. patent discloses a method for encoding a sequences of image frames which contain pixel values for a still image.</p>	Not disclosed in either the Bowater, et al. or Davis, et al. patents.
storing the encoded I frame data; and	Not expressly disclosed in the Gormish, et al. patent.	Not expressly disclosed in either the Bowater, et al. or Davis, et al. patents.

Applicant : Mark D. Conover
Serial no : 09/168,644
For : ENCODING A STILL IMAGE
INTO COMPRESSED VIDEO
Art Unit : 2613

Docket no. 2134
Filed: October 8, 1998
Examiner: Richard Lee

<p>assembling the compressed video bitstream by appropriately combining data for:</p> <p>at least a single copy of the stored I frame;</p> <p>at least one null frame; and</p> <p>various headers required for decodability of the compressed video bitstream;</p> <p>whereby decoding of the compressed video bitstream produces frames of video which produce images that do not appear to pulse visually.</p>	<p>Not disclosed in the Gormish, et al. patent.</p>	<p>The Davis, et al. patent discloses assembling a compressed video bitstream.</p> <p>The Bowater, et al. patent discloses inserting null frames into compressed data to freeze an image's display during intervals in which a workstation becomes starved for data.</p>
	<p>Not disclosed in the Gormish, et al. patent.</p>	<p>Not disclosed in either the Bowater, et al. or Davis, et al. patents.</p>

Applicant : Mark D. Conover
Serial no : 09/168,644
For : ENCODING A STILL IMAGE
INTO COMPRESSED VIDEO
Art Unit : 2613

Docket no. 2134
Filed: October 8, 1998

Examiner: Richard Lee

In re Sovish
Background Knowledge Independent of the References

The invention was a plug adapted for temporarily or permanently:

plugging of . . . aperture members [in electrical junction or outlet boxed] and involves a novel plug in the form of a cylindrical hollow body (first part) closed at one end by a cap (second part). This plug may be positioned in an aperture member or conduit to close it until such time as it is desired to insert a cable or the like there-through, the aperture member then being shrunk around the plug by heating. When the cable is to be inserted, the cap or "second part" is first knocked off, the cable passed through the "first part" or hollow body, and the aperture member further or again heated. This will cause the tubular part of the plug to be forced out, extruded, or "milked out" as the application says (presumably by analogy to milking a cow), due to its tapered shape. The aperture member will then shrink tightly upon and seal the cable. *In Re Sovish*, 769 F.2d, 738, ___, 226 USPQ 771, 772. (Fed.Cir. 1985)

The issue in *In re Sovish* was:

would it have been obvious to one of ordinary skill to use a plug like Esher's in place of Weagant's plug 26. Id. at ___, 773.

In holding pending independent claim obvious under 35 U.S.C. § 103 the Court of Appeals for the Federal Circuit stated:

parts (a) and (b) of claim 1 read on Esher so far as structure is recited. Appellants argue that Esher did not intend to remove his plug from the conduit after knocking the bottom out of it, but to leave it in place as an insulator. But structurally, Esher's plug body is as removable from the conduit as it is insertable and just as removable as Weagant's plug. Esher also contains and teaches the use of a score line to make a closure portion ("second part") detachable. In short, if one put an Esher-type plug into Weagant's heat-recoverable conduit with no more change than to make it the right size, one would have the subject matter of claim 1.

*

*

*

As for resulting in a useful device, appellants are talking about Esher's plug not being removable and being left in the conduit which, they say, "would prevent effective heat recovery." They are assuming that one of ordinary skill would not appreciate that Esher's hollow

member 14 could be removed if it is not wanted, as insulation or otherwise, and that would not be removed by a skilled worker who wished to allow heat recovery of the - conduit in which it was placed. This argument presumes stupidity rather than skill. Id. at ____, 774

In re Jacoby
Background Knowledge Independent of the References

The invention:

is disclosed as including two fluid-carrying "boiler pipes." Interconnecting these pipes are a plurality of radiator core fluid-carrying conduits. The main function of the conduits is to allow for rapid heat transfer from the fluid passing therethrough, to and through the walls of the conduits and thence to the surrounding air. The issue is the obviousness of including in the configuration of such conduits a constriction or "Venturi" portion intermediate their ends. *In re Jacoby*, 309 F.2d 513, ___, 135 USPQ 317 (C.C.P.A. 1962)

Since all that portion of claim 34 down to the last clause thereof is not only clearly shown in Grenell et al. but conceded by appellant to be old, patentability rests entirely on the last clause which reads, "said conduit having at least one intermediate portion there& narrowed into a constriction." The structure of the automobile radiator tubes shown in the *Merritt* patent clearly meets that claim limitation. Each of the tubes has a constriction intermediate its ends. Inherent in such a structure is the creation of turbulence in the fluid flowing through the constriction.

* * *

We further believe, . . . , that it would have been obvious to such persons of skill in the art to utilize in a radiator of the type disclosed by Grenell et al. tubes with constrictions as shown in *Merritt* for the purpose disclosed by Merritt.

While it is true that *Merritt* nowhere discusses turbulence or heat transfer efficiency and was concerned with producing tubes or conduits having resistance to rupture upon the freezing of their fluid contents, the problem cannot be approached on the basis that workers in the art would know only what they could read in the references. Those skilled in the radiator art must be presumed to know something about radiators apart from what the references disclose. Accordingly, it is here immaterial that *Merritt* does not disclose the function of improved heat transfer set forth in appellant's specification, since this is merely an additional attribute

possessed by the Merritt structure³⁹ Id. at
_____, 319

³⁹ Applicant respectfully submits that subsequent decisions have overruled the holding of In re Jacopy sub silentio.

"The mere fact that a certain thing may result from a given set of circumstances is not sufficient" for inherency. Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). If a claimed invention is not clearly anticipated by a reference, i.e. if the invention is not fully disclosed in a single prior art reference or embodied in a single practice or device, arguments of inherency are immaterial. Jones et al. v. Hardy, 727 F.2d 1529-30, 220 USPQ 1021, 1025-26 (Fed.Cir. 1984). Inherency . . . may not be established by probabilities or possibilities. "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed.Cir. 1989).

In re Bozek
No Suggestion Required if Common Knowledge or Sense

. . . [T]he invention relates to "a can end of the easy opening type adapted for the dispensing of beverages including beer, wherein an end panel of the can end is provided with a score line which defines a tear-out portion through which the beverage is poured". The specification does not state explicitly how the score line is provided, but in his briefs to the board and this court, appellant has indicated that the score line is formed by compressing the material of the can end in a die-stamping operation, as opposed to a cutting or metal-removing operation. This compression causes a flowing of the metal in directions away from the score line, thus causing a gathering of metal within the tear-out portion defined by the score line and a generally circumferential bulging of the metal outwardly from the score line.

* * *

Appellant proposes to solve the problems he describes by providing a circumferentially extending rib in the end panel, which rib is offset from the plane of the end panel in either an upward or downward direction. This rib, or groove as it may be, serves, according to appellant, to absorb the excess metal resulting from the forming of the score line, while at the same time functioning as a circumferential reinforcement to stiffen the entire end panel. Appellant states that the rib may extend continuously around the circumference of the can end or it may be in a C-shape with the ends terminating closely adjacent to the opposite sides of the tear-out portion. *In re Bozek*, 416 F.2d 1385, ____, 163 USPQ 545, 546 (C.C.P.A. 1969)

Having established that . . . knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *Id.* at ____, 319 (Citations Omitted.)

However, see Smiths Industries Medical Systems v. Vital Signs,
183 F.3d 1547, ____ USPQ2d ____ (Fed.Cir. 1999).

Vital Signs has not offered sufficient independent evidence to support the district court's decision to combine elements from different references, arguing only that the suggestion to combine references may come from the knowledge and common sense of a person of ordinary skill in the art. See, e.g. In re Bozek, 57 C.C.P.A. 713, 416 F.2d 1384, 1390, 163 USPQ 545, 549 (CCPA 1969). That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. See C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir. 1998); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297-98, 227 USPQ 657, 667 (Fed.Cir. 1985). Vital Signs thus failed . . . to establish why one of ordinary skill would have found it obvious to combine the numerous claim limitations in a particular way to achieve the . . . invention. Therefore the district court's judgment of invalidity must be reversed Id. 1356, ____.

In re Keller
References Cannot Be Attached Individually

The claimed invention is a cardiac pacer having a digital counter. In re Keller, 64 F.2d 413, 208 USPQ 871 (CCPA 1981)

To rebut the prima facie case of obviousness established by the examiner, appellant filed an affidavit of Jozef K. Cywinski, Ph.D. This affidavit, according to appellant, "concerns itself mainly with the question of whether the Walsh et al. article suggest (sic) the use of digital timing in a cardiac pacer * * * ." Id. ____, 879

[T]he sole issue regarding the prior art rejections is essentially whether the references, taken collectively, would have suggested the use of digital timing in a cardiac pacer to those of ordinary skill in the art at the time the invention was made. Id. ____, 880

As characterized by appellant, the Cywinski affidavit offered as objective evidence of non-obviousness "concerns itself mainly with the question of whether the Walsh et al. article suggest [sic] the use of digital timing in a cardiac pacer * * * ." But one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. Id. ____, 882

However, see In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed.Cir. 2000).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed.Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). **Whether the Board relies on an express or an implicit showing, it must**

provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. Id. 1369, 1316.

See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, (Fed.Cir 1988) that also cites In re Keller.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." But [obviousness] "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. 1075, 1599. (Citations omitted.)